

Application No. 09/943,397

### **REMARKS**

The Examiner has rejected claims 21-29 under 35 USC 112 for lacking antecedent basis for the term "computer." This rejection has been overcome by the above Amendment.

The Examiner has rejected claims 21-29 over Shih in view of Lo. With regard to claim 21, from which all of the other claims are dependent, Shih teaches all of the claimed steps except sending data to a destination port of the destination computer, and polling the file location. Lo, further according to the Examiner, teaches a scanning system wherein the image is sent from the scanner to the destination port.

Claim 21 recites:

A method of scanning a document at an input scanner and recording image data derived from the document at a selected destination computer among a population of destination computers, comprising:

entering, at a user interface associated with the input scanner, a destination of a document scanned at the input scanner, the destination including a reference to a ***predetermined file location retained in the destination computer***;

the ***destination computer polling the file location***; and

image data moving from the input scanner ***directly to a port*** associated with the destination computer.

Examiner alleges that the primary reference, Shih, teaches entering the predetermined file location in the destination computer. However, even by the exact passages in Shih quoted in the rejection, this is not the case. One passage in Shih cited to show specifically "image data moving ... directly to the destination computer" is at lines 50-64 of column 3 of Shih. This passage, however, clearly states that "the document signals are transmitted across the network in an *electronic mail (e-mail) format*" (column 3, lines 51-54, emphasis added). As is well known in the art, in order to sustain any electronic mail format,

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there *must* be provided some sort of infrastructure, typically including at least one e-mail server, interposed between the source and the destination of the data. At the very least, a person skilled in the art, reading the description of an e-mail format in Shih, would see a teaching *away* from the claimed invention, in which image data is moved directly to the destination computer, *without* any intervening computer as would be required to sustain an e-mail format.

In addition to the above deficiency with Shih, Examiner points out that Shih does not explicitly teach sending data to a destination port of a destination computer and polling the file location.

The secondary reference, Lo, is cited for teaching a scanning system wherein the image is sent from the scanner to the destination port. However, whatever is mentioned in isolated passages thereof, in Lo there is certainly a scanner *server* interposed between a scanner and a destination computer, or client computer:

It is another object of the invention to provide a network scanning system which allows an application program running on a client computer to control and receive information from an image scanner over a computer network, in a manner **which is similar to having the scanner directly connected to the client computer.**

\* \* \*

These and other objects are accomplished by a network image scanning system which includes a client computer and a **scanner server computer connected by a network**, the server computer having the scanner connected thereto. According to a first aspect of the invention, a virtual TWAIN driver is utilized by an application-program running in the client computer. The virtual TWAIN driver allows the application program to act, to a certain extent, **as if the client computer is directly connected to an image scanner, even though the scanner is connected to a scanner server**, the scanner server being connected to the client computer over a computer network. (Column 2, lines 11-33, emphases added)

By its own admission, Lo teaches that it is desirable that a scanner server be invisible so that the scanner "seems" to be directly connected to the client

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computer— but there is *still* a scanner server between the scanner and the destination computer. With the claimed invention, there is *actually* a direct connection between a scanner and a destination computer, *without* an intermediate server.

According to MPEP § 2141, when applying 35 USC § 103, the examiner must adhere to the basic tenets of patent law, *inter alia*: The claimed invention must be considered *as a whole*; and the references must be considered *as a whole* and must suggest the *desirability* of making the combination. As a whole, the claimed invention recites a direct connection (i.e., with no interposed server) between a scanner and a port of a destination computer. Similarly, as a whole, Shih teaches moving data through a network in an e-mail format, which is a teaching away from the idea of direct connection to the destination computer. Lo clearly teaches the existence of an intermediate network server. **Neither reference, alone or in combination, teaches or suggests a direct connection between a scanner and a port of a destination computer.** The individual passages cited in the rejection are beside the point. For this reason, claim 21 and its dependent claims are allowable.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-3811, Rochester, NY.

Respectfully submitted,

A handwritten signature in cursive script, reading "Robert Hutter", written in black ink.

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